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Attorney Docket No. RPP135FUS
U.S. Patent Application No.08/811,361
Date: January 2, 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Molly F. Kulesz-Martin

U.S. Patent Application No. 08/811,361

For: p53as PROTEIN AND ANTIBODY THEREFOR

Filed: March 4, 1997

Examiner: Christopher H. Yaen

Group Art Unit: 1642

Confirmation No.: 1038

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I certify that this Amendment and Request for Reconsideration is being deposited on January 2, 2004 with the U.S. Postal Service as first class mail under 37 C.F.R. §1.8 and is addressed to the Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

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REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Honorable Sir:

This is in reply to the Examiner's Answer November 4, 2003.

In the Examiner's Answer, for the first time, the Examiner significantly expanded upon the lack of utility rejection under 35 U.S.C. 101.

In the Examiner's Answer, the Examiner failed to state several significant points.

One of the most important of those points is that it has already been established in the prior art that p53 without its carboxy terminal sequence acts biologically the same as full p53

except that the negative regulatory domain is absent thus resulting in p53 activity that is constant rather than activity that can be turned off. The members of the Board are referred to Hupp et al. "Regulation of the specific DNA binding function of p53", *Cell* 71, pp 875-886 (1992), of record.

The specification further contains significant information showing that active p53 and in particular p53as have tumor suppressing function. It is had to imagine a more pertinent utility. The specification further sets out methodology for utilizing p53as for studies of cell growth suppression, differentiation between p53 and p53as and in identification of cells having aberrant behavior due to over or under expression of p53as, see e.g. the bottom of page 1, figures 9A through 9F, Figures 10A through 10F, page 10 first full paragraph, the paragraph spanning pages 10 and 11, the second full paragraph on page 11, the paragraph spanning pages 11 and 12, the paragraph between pages 12 and 13 , etc.

There is hardly a lack of utility.

We believe that the Examiner has mischaracterized the opinion of the Board in paper number 17. The Board in fact held in favor of the Appellants on the issue of homology of p53as with full length p53. The Board reversed the Examiner's rejections and entered a new ground based upon whether mouse and human p53as could represent the genus. That issue has now apparently been resolved by restricting the claims to p53as containing specific sequences and no 35 U.S.C. 112 rejections remain. The Examiner seems to be revisiting the rejections already overturned by the Board by recouching them as utility rejections.

The Examiner should be reversed and the remaining claim should be allowed.

Respectfully submitted,

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